

Remarks

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 195-211 and 240-249 were rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite because the limitation regarding the “uncommitted balance of the selected gift’s purchase price” is allegedly not linked to the “receiving commitments” limitation. Claims 212-230 and 232-239 allegedly contain a similar issue. While Applicants do not agree that the claims are indefinite, independent claims 195, 199, 200, 207-209, 212, 218-220, 226-228, 234, 240, 245, 250 and 251 have been amended by way of expediency, not by way of acquiescence, to specify that the on-line display of gift ideas reflects uncommitted balances of purchase prices (or total gift amounts) for one or more gift ideas having a partial purchase option. These amendments are believed to address the issues raised in the office action. Conforming amendments have been made to claims 202, 204, 214, 216, 222, 224, 230, 232, 236, 238, 242 and 247. In addition, claims 225, 233 and 239 have been amended to correct minor informalities.

In view of these amendments, withdrawal of the Section 112, second paragraph, rejection is respectfully requested.

Claims 195, 196, 198, 201, 204-212 and 216-220, 226-228 and 234¹ were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over "UCOPIA: Ucopia Unveils New Wedding Registry Partners ..." (the “Ucopia document”) in view of Douglass (“Experience vs. Logic in Fund Raising”, Fund Raising Management, v23, n4, page 44(3), June 1992) (“Douglass”).

Independent claim 195, 207, 208 and 209 are directed, among other things, to enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of *any giver-desired amount* toward a purchase price of a gift for a gift recipient. An illustrative implementation of this "partial purchase" feature is described,

¹ Although not identified in this statement of the rejection, the body of the rejection also addresses claims 224, 225, 232, 233, 238 and 239. See Office Action, page 8. As such, Applicant assumes that these claims should have been included in the statement of the rejection.

for example, on pages 24-26 of the subject application and permits a plurality of gift-givers to each make a contribution toward a gift. Significantly, in accordance with the methods and systems set forth in these claims, each gift giver can make a commitment for *any giver-desired portion* of the remaining balance of a gift. See, e.g., claim 195, ll. 20-22 (“...wherein the commitment of each giver that commits to make a monetary contribution is for *any giver-desired portion of the uncommitted balance* of the selected gift's purchase price”).

The Ucopia system provides a “group purchase” feature in which

[c]ouples designate an item for group purchase on their registry form and specify the dollar amount of shares to be sold. Typically, a share is \$50. Individual guests can then purchase one or more shares. The gift remains on the couple's registry until it is fully purchased. If the full purchase price is not reached, the couple may either purchase the remaining shares or obtain a gift certificate to the retailer for the total amount of the shares already purchased. *Ucopia website, Frequently Asked Questions*

The Ucopia document does not disclose (or even suggest) a method or system in which each giver can commit to make a monetary contribution for any giver-desired portion of the uncommitted balance of the gift's purchase price. In the Ucopia system, the commitment of each giver that commits toward the purchase of a gift is constrained by the share price specified for that gift. Thus, a user may not contribute \$25 or \$75, for example, toward the purchase of a gift whose share price has been set to \$50. In complete contrast to the Ucopia system, the arrangements of claims 195, 207, 208, and 209 permit a gift giver to contribute as much or as little as he or she wants. This results in greater convenience for gift recipients, and maximizes the amount of gifts received. For example, a gift giver wishing to spend \$75 can spend exactly \$75.

Douglass is alleged to be “in the same field of endeavor” as the Ucopia system and is alleged to disclose that each giver in a group of givers can commit to make monetary contributions for any giver-desired portion of the uncommitted balance of a predetermined donation amount. 3/15/2005 Office Action, page 6. The office action is presumably relying on the following disclosure in Douglass to support this contention:

In addition, the donor is frequently persuaded to increase his or her gift when you can say, for example, "We have already raised \$4.8 million. We only have \$200,000 left to raise to reach our \$5 million goal. Your gift of \$10,000 will help make the difference."

As is clear from the title, Douglass relates to fund raising from donors and has nothing to do with a system or method involving an on-line display of gift ideas. It is difficult to conceive how Douglass would have suggested any modification whatsoever to the Ucopia system, particularly any modification that would have resulted in the claimed subject matter.

More specifically, Douglass relates to an arrangement in which a volunteer directly contacts a donor to solicit money for a fund raiser. The above excerpt from Douglass provides a script for use by the volunteer to try to persuade a donor to increase the amount of money he/she contributes. The Ucopia system involves no such direct contact with a donor and no such attempts by a volunteer to "persuade" such a donor to increase his/her giving. Absent impermissible hindsight, this script for attempting to persuade a donor to increase his/her donation is not suggestive of any modification to the Ucopia system, much less a modification that would have resulted in a system in which a giver may commit to a giver-desired portion of an uncommitted balance of a purchase price (or total gift amount) of a gift selected from an on-line display of gift ideas.

Indeed, Douglass' description of a recipient-suggested donation amount (\$10,000) is suggestive of the recipient-specified share price of the Ucopia system, which as noted above, is contrary to the claimed systems and methods. There is simply nothing in Douglass that would have suggested the modifications to the Ucopia document proposed in the office action to provide the subject matter of claims 195, 207, 208 and 209.

Moreover, in view of the differences between the Ucopia system and the fund-raising discussion of Douglass, Applicants submit that there would have been no motivation to make the proposed combination. Indeed, Applicants note that the desirability of the combination as stated in the office action on page 6 and 7 appear to be drawn from the advantages of the inventive systems and methods mentioned in responses to prior office actions, not from anything discerned from the documents themselves.

Independent claims 212, 218, 219 and 228 specify, among other things, that at least one gift idea from the gift recipient specifies a substitute gift. In the illustrative embodiments of the subject application, this feature enables a gift recipient to specify a substitute gift in the event, for example, the original gift specified in the gift idea is not available for some reason. This substitution feature is not found in either the Ucopia document or Douglass, and the office action does not address this feature in connection with these claims. Because this feature is missing from the applied documents, the proposed combination thereof cannot possibly provide this feature. For at least these reasons, these claims are believed to be allowable over the proposed combination of the Ucopia system and Douglass.

Independent claims 220, 226, 227 and 234 specify, among other things, that each giver can commit for part of the total gift amount specified for a selected gift even if the only gift amount specified by the gift idea for the selected gift is the total gift amount. No such feature is disclosed or suggested by the Ucopia system or Douglass. As noted above, Douglass relates to fund raising and does not disclose any concept relating to selecting a gift from an on-line display of gift ideas. Moreover, in the Ucopia document, the gift recipient must specify a share amount in order to permit the "group purchase" described therein. The specification of share amount requires the gift recipient to perform an extra step, thereby increasing the time and effort expended to set up the registry. Moreover, retail prices are often of odd amounts, for example, \$979.99 and are not readily divisible into shares. The gift recipient must therefore spend additional time calculating a share amount at which these odd amounts can be divided into equal shares. Since the typical wedding registry may have 50 to 200 items, the additional steps of specifying a share amount and the number of shares for each gift could be quite time consuming. In complete contrast to the system described in the Ucopia document, the arrangements of claims 220, 226, 227 and 234 do not require the extra steps of setting a share amount or a number of shares and thus are more convenient and less time consuming to use.

Furthermore, some gift prices may not be divisible into equal shares at all. If the gift price is equal to a prime number (*e.g.*, \$1,333.37), then it would be impossible to

divide the price into equal shares. There are approximately 8,000 "prime number" price points under \$1,000.00 that cannot be split into equal shares. A similar problem arises if some default share amount (*e.g.*, \$50.00) is used. A \$1,333.37 gift cannot be divided into a whole number of equal \$50.00 shares. Here again, in complete contrast to the system described in the Ucopia document, the arrangements of claims 220, 226, 227 and 234 are readily usable for all price points.

Finally, gift recipients typically lack sufficient information to set an optimal share price since they have no idea as to what potential gift givers are willing or are able to spend. If the share price is set too high, too few gift givers will be able to afford the shares. If the share price is set too low, there may be an insufficient number of givers to purchase all of the shares.

For all these reasons, Applicants respectfully submit that claims 220, 226, 227 and 234 cannot be rendered obvious by the proposed combination of the Ucopia document and Douglass.

In addition to the reasons advanced with respect to the claims from which they depend, various dependent claims contain additional patentable features not taught or suggested by the proposed combination of the Ucopia document and Douglass.

By way of example, with respect to claims 204-206, 216, 217, 224, 225, 232, 233, 238 and 239, the office action alleges that the concepts of receiving cash if the total of commitments is less than gift's purchase price and of one or more gift ideas being associated with a recipient-determined price or vendor are "well-established business practices and therefore inherent to this reference." 3/15/2005 Office Action, page 8. Applicants once again note that there is no documentary evidence to support these contentions and again respectfully request that such evidence be provided to support these contentions if any rejection is maintained. Nor is there any evidence at all to support the contention that these features are "inherent" (*i.e.*, necessarily present). For example, there is no disclosure in the cited documents of recipient-determined or specified prices or gift amounts for gift ideas as specified in claims 205, 217, 225, 233 and 239 and Applicant does not understand these concepts to be necessarily present as is required to sustain an allegation of inherency. Similarly, there is no disclosure in the

cited documents, for example, of recipient-determined vendors as specified in claim 206 and Applicant likewise does not understand this concept to be necessarily present.

In addition, while the Ucopia system provides that incomplete purchases can be given to the registrant in gift certificates, there is no disclosure of providing the commitments for monetary contributions to the gift recipient as cash if the total of the commitments is less than the gift's purchase price as specified in claims 204, 216, 224, 232 and 238. Unlike cash, gift certificates generally (1) can only be used in certain stores; (2) have expiration dates; and (3) are generally non-transferable. Moreover, gift certificates are backed only by the credit of each respective store.

Claims 197, 213, 221, 229 and 235 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the Ucopia document-Douglass combination, in further view of the "weddingchannel.com" document. The weddingchannel.com document is applied as teaching a registry in which web pages are generated and supplied to gift givers. However, the weddingchannel.com document does not remedy the above-noted deficiencies of the proposed Ucopia document-Douglass combination in connection with claims 195, 212, 220, 228 and 234 (from which claims 197, 213, 221, 229 and 235 respectively depend). As such, even assuming for the sake of argument that the combination of these documents would have been proper and that the combination were made, the subject matter of claims 197, 213, 221, 229 and 235 would not result.

Claims 199 and 200 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over the proposed combination of the Ucopia document and Douglass, in further view of Ojha et al. (U.S. Patent No. 6,598,026). Ojha et al. discloses methods and apparatus for facilitating a transaction between a buyer and one of a plurality of sellers via the internet. Ojha et al. does not describe gift-giving systems and thus does not, for example, disclose the concept of a vendor sending a gift to a gift recipient as specified in claims 199 and 200.

Moreover, Ojha et al. does not disclose or suggest the concepts of a gift list or of aggregating purchase requests for identical gifts into a single purchase order as specified in claim 200. With reference to the Abstract and background of the Invention section, the office action simply alleges that Ojha et al. discloses sending a request for a purchase of a

plurality of products and subsequent consummation of the purchase request. However, Applicants understand the “plurality of products” referenced in the Ojha et al. Abstract to refer to different products, not aggregated purchase requests for a plurality of identical products. As such, the proposed combination of Ojha et al. with Ucopia and Douglass would not have resulted in the subject matter of claim 200.

In addition, like independent claim 195, 207, 208 and 209, independent claims 199 and 200 are directed, among other things, to enabling a plurality of gift givers to each make a respective commitment for a monetary contribution of *any giver-desired amount* toward a purchase price of a gift for a gift recipient. Ojha et al. does not remedy the deficiencies of the Ucopia document and Douglass with respect to commitments of any giver-desired amount and thus, even if these three references were forcedly combined, the subject matter of claims 199 and 200 would not result.

Claims 202, 214, 222, 230 and 236 were rejected under 35 U.S.C. Section 103(a) as allegedly being “obvious” over the proposed Ucopia-Douglass combination, in further view of Kopetman (“Starr Rides to Freedom Bowl Rescue Last-Day Scramble Secures Necessary Loans, Donations”, Los Angeles Times, June 28, 1996, page 5). The Kopetman article describes a \$125,000 loan by the city that included a clause stating the loan was “contingent upon the receipt of other funds, gifts and contributions totaling \$402,000 - or the remainder needed to meet the \$527,000 payment - by Monday.” A loan having a contingency clause relating to the securing of additional financing for keeping the Freedom Bowl in Anaheim, California has nothing to do with the purchasing of gifts from an on-line display of gift ideas. To the extent any relationship can even be identified, it is based on improper hindsight gleaned from the subject patent application. In addition, claims 202, 214, 222, 230 and 236 are believed to be allowable for the reasons advanced with respect to the claims from which they respectively depend.

Claims 203, 215, 223, 231 and 237 were rejected under 35 U.S.C. Section 103(a) as allegedly being “obvious” over the proposed combination of the Ucopia document and Douglass, in further view of Linstedt. Applicants note that claims 215 and 231 were previously canceled. Each of claims 203, 223 and 237 (along with claims 212 and 228) calls for a gift recipient to specify a substitute gift. The Linstedt article contains a

generalized mention of a shopper who made a list including substitute gifts for shopping on the day after Thanksgiving. This newspaper article has nothing to do with the disparate gift-giving arrangements described in the Utopia document and Douglass and in no way would have suggested modifying either of these gift-giving arrangements (or some proposed combination thereof). Moreover, any substitute gifts mentioned in newspaper article are specified in a list of the gift giver -- there is no disclosure whatsoever of a recipient-specified substitute gift and any assertions to the contrary are simply not supported by the Linstedt article itself. Consequently, for at least these reasons, claims 203, 212, 223, 228 and 237 are believed to be allowable.

In addition, claims 203, 223 and 237 are believed to be allowable for the reasons set forth with respect to the claims from which they depend.

The office action does not address claims 240-251 in detail. Rather the office action suggests that reference be made to the discussion regarding "claims 195 and 203 combined." However, this discussion is deficient with respect to the claimed subject matter for the reasons set forth above. For example, nothing in any of the cited documents discloses or suggests the concept of a recipient-specified substitute gift as specified in these claims. The only document cited in the office action in this regard (i.e., Linstedt) involves a generalized reference to a giver-specified list of substitute gifts. For at least these reasons, the subject matter of claims 240-251 is believed to distinguish over the proposed combination of documents.

Hsu et al.


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Applicant submits that the pending claims are in condition for allowance, and action to that end is earnestly solicited.

Respectfully submitted,

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